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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,439	08/20/2003	Curtis R. Richardson	OTTR.01USC1	7991

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EXAMINER

EDWARDS, ANTHONY Q

ART UNIT	PAPER NUMBER
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2835

DATE MAILED: 09/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/645,439

Applicant(s)

RICHARDSON, CURTIS R.

Examiner

Anthony Q. Edwards

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 17, 18, 23, 27, 28, 33 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,068,119 to Derr et al. ("Derr" hereinafter). Referring to claim 17, Derr discloses a protective enclosure (1) for a touch screen device (100) having a touch screen (106, 108) comprising a shell (2, 4) that is capable of enclosing said touch screen device (100), said touch screen device being a separate unit from said protective enclosure, said touch screen device being insertable in and removable from said enclosure by hand (see col. 2, lines 7-10), said shell being substantially crush-resistant (see col. 1, lines 60-67) and having an elevated protective rim (not numbered) around a perimeter portion of said touch screen (106, 108) of said touch screen device so that when said touch screen device is disposed in said enclosure, said touch screen of said touch screen device is recessed with respect to said protective rim of said shell so that said elevated protective rim protects said touch screen from breakage. See Figs. 1 and 2A, which show the touch screen (106, 108) of said touch screen device (100) is recessed with respect to the protective rim of said shell (2, 4). Derr also discloses a flexible protective membrane (6) that is integrally fixed on said shell (2) so that said flexible protective membrane is disposed over said touch screen (106, 108) of said touch screen device (100) when said touch screen device is disposed in said enclosure, said flexible protective membrane (6) having a back

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side (not numbered) that has a substantially planar smooth surface that is adjacent to said touch screen of said touch screen device when said touch screen device is disposed in said enclosure so that tactile inputs on a front side (not numbered) of said flexible protective membrane are communicated to said touch screen through said flexible protective membrane, said flexible protective membrane being at least partially transparent such that said touch screen is visible through said flexible protective membrane. See Figs 1 and 2A, as well as col. 4, lines 1-11.

Referring to claim 18, Derr discloses a protective enclosure wherein the enclosure is watertight. See col. 4, lines 12-18.

Referring to claim 23, Derr discloses a protective enclosure wherein said protective enclosure uses at least one snap (12, 14) to securely close said enclosure (1) around said separate touch screen device (100). See Fig. 3D and the corresponding specification.

Referring to claims 27 and 28, the method steps are necessitated by the device structure of claims 17 and 18, respectively, as disclosed by Derr.

Referring to claims 33 and 34, Derr discloses a protective enclosure as claimed. Although said claims are limited by and defined by the recited process, the determination of patentability of the product is based on the product itself, and does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by the different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Derr in view of U.S. Patent No. 6,415,138 to Sirola et al. ("Sirola" hereinafter). Derr discloses the device as claimed, except for the flexible protective membrane being sufficiently thin to transmit smooth strokes from a stylus to the touch screen without interruption of said strokes, said flexible protective membrane being sufficiently smooth and sufficiently firm to prevent said stylus from catching on said membrane. Sirola teaches providing a "foil-like," transparent polycarbonate material (5) for activation of a touch screen device display (3). See col. 4, lines 3-11. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the protective enclosure of Derr to include a sufficiently thin membrane to transmit smooth strokes from a stylus, as taught by Sirola, since the device of Sirola would allow the device of Derr to be utilized in modern PDA devices, which require continuous and simultaneous slide pressing of a stylus device for activation.

Claims 20-22, 24-26 and 29-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Derr in view of Sirola, and further in view of U.S. Patent No. 6,456,487 to Hetterick. Referring to claim 20, Derr, as modified, discloses the protective enclosure as claimed, except for the protective enclosure having grip-enhancing structures. Hetterick teaches provided first and second grip members (58, 60) on a protective enclosure for wireless communication devices.

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It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the protective enclosure of Derr to include hand grip members, as taught by Hetterick, to prevent inadvertent release, i.e., dropping, of the device in wet environments.

Referring to claim 21, Derr in view of Sirola, and further in view of Hetterick disclose the protective enclosure as claimed, including having cushioning that protects the touch screen from mechanical shock. See col. 1, lines 42 and 43 of Derr.

Referring to claims 22 and 29, Derr in view of Sirola, and further in view of Hetterick disclose the protective enclosure and method of manufacturing the same as claimed. See col. 4, lines 1-11 of Derr.

Referring to claims 24 and 31, Derr in view of Sirola, and further in view of Hetterick disclose the protective enclosure and method of manufacturing the same as claimed. See col. 5, lines 12-16 of Sirola.

Referring to claims 25, 26, 30 and 32, Derr in view of Sirola, and further in view of Hetterick disclose the protective enclosure and method of manufacturing the same as claimed. See col. 6, lines 44-67 of Sirola.

Response to Arguments

Applicant's arguments with respect to claims 17-34 have been considered but are moot in view of the new ground(s) of rejection.

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Conclusion


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: U.S. Patent No. 6,536,589 to Chang discloses a protective device for a PDA.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Q. Edwards whose telephone number is 571-272-2042. The examiner can normally be reached on M-F (7:30-3:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynn D. Field, can be reached on 571-272-2800, ext. 35. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

September 22, 2004
aqe


LYNN FIELD
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